

Applicant : Andrew Schydlofsky
Serial No. : 10/697,767
Filed : October 30, 2003
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Attorney's Docket No.: 15651-002001

Amendments to the Drawings:

The attached replacement sheets of drawings include changes to Figures 1-3 and replace the original sheets of Figures 1-3. In addition, new formal Figure 4 is attached.

The informal drawings of Figures 1-3 have been replaced by formal drawings of the same.

Attachments following last page of this Amendment:

Replacement Sheet (3 pages)
New Sheet (1 page)

REMARKS

Claims 26-34 and 45-49 were pending. The Examiner rejected claims 26-34 and 45-49 under 35 U.S.C. § 103(a) as being unpatentable over Baron *et al.* (U.S. Pat. No. 6,482,451) (“Baron”) and rejected claims 26-28, 30-32, and 45-49 under 35 U.S.C. § 103(a) as being unpatentable over Lloyd *et al.* (U.S. Pub. No. 2002/0110622) (“Lloyd”). In addition, the Examiner objected to the drawings under 37 C.F.R. § 1.83(a).

Applicants have herein amended claims 26 and 31 and cancelled claims 30, 32, and 45. Support for the amended claim can be found throughout the specification and the original claims, specifically, on page 4, lines 6-9; page 4, lines 17-18; page 4, lines 27-29; page 7, lines 21-24; and page 8, lines 10-16. In addition, Applicants have introduced a new drawing, Figure 4, in response to the Examiner’s objection. Support for this new figure can be found on page 6, lines 6-7, page 6 lines 9-10, page 6 line 29 to page 7 line 2, and page 7, lines 15-16. No new matter has been added. Accordingly, claims 26-29, 31, 33, 34, and 46-49 are pending.

In light of the remarks set forth below, Applicant respectfully requests reconsideration and allowance of claims 26-29, 31, 33, 34, and 46-49.

Objection under 37 C.F.R. § 1.83(a)

The Examiner objected to the drawings under 37 C.F.R. § 1.83(a), stating that the drawings did not show every feature of the invention specified in the claims. Specifically, the Examiner stated that the drawings did not show the following features:

(cl. 47) that the dietary supplement product and the at least one additive package are combined into one package; (cl. 48) that the dietary supplement product is contained in a package, the package comprising a holder adapted to hold the at least one additive package; and (cl. 49) that the holder is integral with the dietary supplement package.

Applicants respectfully disagree. With respect to the Examiner’s objection based on the features of claim 47, Figures 1A and new Figure 4 demonstrate a dietary supplement product and at least one additive package combined into one package (see, e.g., page 6, lines 14-19). For example, Figure 1A illustrates a container for the dietary supplement (20) and an attached holder

(30) which contains at least one additive package (40). Applicants assert that while the holder is removable, one skilled in the art would recognize that the two-piece system is combined to create one unit or package (100).

In response to the rejection based on claim 48, Figures 1A and 1B illustrate a dietary supplement product contained in a package which further includes a holder adapted to hold at least one additive package (see, page 6, lines 14-29). For example, Figure 1A is described on page 6, lines 14-19, as follows: “[p]roduct 100 includes a base 10 contained within a container 20. A holder 30, can be removably attached to container 20...Packaged product 100 can be designed so that it is suitable for placing one or more packaged additives 40 in holder 30.” Accordingly, Figures 1A and 1B illustrate two examples of the features of the invention as specified by claim 48.

To address the Examiner's objection based on claim 49, Applicants have herein added new Figure 4. Figure 4 shows two examples of the features as specified in the claim, specifically, an additive holder which is integrated with the dietary supplement package.

Given the arguments and amendments above, Applicants respectfully request withdrawal of the objections.

Rejections under 35 U.S.C. § 103(a)

The Examiner rejected claims 26-34 and 45-49 under 35 U.S.C. § 103(a) as being unpatentable over Baron, stating that Baron shows a kit for making a product with at least one additive packaged separately from the product. The Examiner acknowledged that Baron does not teach a dietary supplement product. The Examiner took “official notice” that it was notoriously old and well known in the art to provide a dietary supplement product, stating that it was well known to provide a milk fortified with additional vitamins, and that it would have been obvious to one of ordinary skill in the art to modify the apparatus of Baron by providing a dietary supplement in order to provide a healthier product. The Examiner also stated that although Baron did not teach a container having a plurality of servings nor providing a plurality of individually packaged additives, he took “official notice” that it was notoriously old in the art to do so.

The Examiner also rejected claims 26-28, 30-32, and 45-49 under 35 U.S.C. § 103(a) as being unpatentable over Lloyd. The Examiner stated that Lloyd shows a kit for making a product and at least one additive packaged separately from the product. The Examiner acknowledged that Lloyd did not teach a dietary supplement product. As with Baron, the Examiner took “official notice” that it was notoriously old in the art to do so.

Applicants respectfully disagree with the rejection. Proper analysis under § 103 requires consideration of two factors: (1) whether the prior art would have suggested to those of ordinary skill in the art that they should make the claimed composition, and (2) whether the prior art would also have revealed that in so making, those of ordinary skill would have had a reasonable expectation of success. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Present claim 26 recites *a kit* for making a nutritional supplement. The kit includes a dietary supplement product, where the dietary supplement product is a powder comprising one or more of a protein, peptide, amino acid, carbohydrate, electrolyte, herb, or combination thereof, and at least one additive, where the additive is packaged separately from the dietary supplement product. Neither Baron nor Lloyd, either alone or in combination, teach or suggest such a kit.

Both Baron and Lloyd teach an apparatus specifically for use with a liquid beverage (e.g., milk). The Baron and Lloyd apparatuses clearly are directed to providing convenience mechanisms for a conventional food item. Lloyd teaches “a portable, liquid and dry consumable product container, and dry consumable product for use therewith, that provides optimal dispensing of dry consumable product therefrom” (Page 1, paragraph [0007]), with a goal of providing a transportable way to consume these two products, for example, ready-to-eat cereal and milk. Baron teaches a tubular body (e.g., a straw) containing a flavoring agent for use with a compatible unflavored beverage, with a goal of addressing the disadvantages associated with pre-flavored beverages. At no point do either Baron or Lloyd teach or suggest the use of a dietary supplement base component in *powdered* form as required by the pending claims. In fact, both Baron and Lloyd require the use of a liquid base and therefore teach away from the use of a base in powdered form.

As stated above, neither Baron nor Lloyd teach or suggest the use of a non-liquid dietary supplement. The references require a liquid component, which in their preferred embodiments is milk. While the Examiner asserted that fortified milk can be considered a dietary supplement,

and that it would have been obvious for one of ordinary skill to modify the inventions of Baron and Lloyd in order to create a healthier product, Applicants respectfully assert that one of ordinary skill in the art would not have had a motivation to substitute the liquid component of Baron and Lloyd with a powdered counterpart. Neither reference suggests to a person having ordinary skill in the art that they should modify the apparatus of the other to change the milk or liquid beverage to a powder. Such a modification would not have addressed the problem each was trying to solve, e.g., providing convenience mechanisms for consuming a liquid beverage such as milk. Furthermore, one of ordinary skill in the art would not have had a reasonable expectation of success in substituting the liquid base of Baron and Lloyd with one in powdered form to achieve a kit comprising a dietary supplement. Therefore, Applicants respectfully request withdrawal of the rejections.

In addition, the Examiner stated that the Applicants traversal of the Examiner's taking of official notice was not provided in the previous Office Action response. Specifically, the Examiner stated that:

[t]o the extent that the Applicant's noting of the official notice is intended as a traversal, the traversal is inadequate because it does not specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art.

Applicants respectfully disagree. In the Response to Office Action mailed March 6, 2006, Applicants made a clear traversal of the Examiner's "official notice" in conjunction with their traversal of the rejections made under 35 U.S.C. § 103(a) to which the Examiner linked his "official notice" (see, Response page 8, line 8). For example, Applicants characterized the rejection and quoted the Examiner's "official notice" followed immediately by the statement, "Applicant respectfully disagrees." Furthermore, the Applicants traversal was not inadequate as Applicants did not make a general allegation, but instead provided a specific argument as to why the Examiner's "official notice" was inappropriate. Beginning on page 7, line 19 of the previous response, Applicants stated:

Moreover, at no point does either Baron or Lloyd suggest modifying his respective apparatus to provide a dietary supplement; there is simply no motivation to do so based on the references, either alone or in combination. The mere fact that dietary supplement products exist and can be "provided" is not a sufficient basis for the Examiner to assert a motivation to modify the

apparatuses of Baron or Lloyd to substitute a nutritional supplement for a conventional food item. The Baron and Lloyd apparatuses clearly are directed to providing convenience mechanisms for the ingestion of conventional food items. They provide no suggestion that the conventional food products provided therein should be replaced with dietary supplements.

Moreover, to the extent that the Examiner relied on official notice to reject claims 26-43 and 45-49 as obvious, both previously and currently Applicants traverse the official notice taken. "Providing" a dietary supplement, which was asserted by the Examiner to be notoriously old and well-known in the art, is not a requirement of the pending claims. The pending claims are not method claims directed to providing a dietary supplement, but are instead directed to *a kit* which includes a dietary supplement and an additive. Therefore, the "official notice" asserted by the Examiner does not apply. Moreover, and importantly, Applicants assert that the Examiner's official notice is improper because obviousness is a *legal* conclusion that can not be made by official notice. As indicated by MPEP 2144.03, "[i]n *limited* circumstances, it is appropriate for an examiner to take Official Notice of *facts* not in the record." MPEP 2144.03 (emphasis added.) Whether claimed subject matter is obvious is a *legal*, not a factual determination. Therefore, Applicants respectfully request the withdrawal of the official notice as improper.

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CONCLUSIONS

Applicant respectfully asserts that all claims are in condition for allowance, which action is respectfully requested. The Examiner is invited to telephone the undersigned attorney if such would expedite prosecution.

Please apply any charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: 11/9/03

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